

**PATENT**

Attorney Docket No.: 408392

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Gregory Winfield Gorman

Group Art No.: 1772

Serial No.: 10/633,943

Examiner: Nasser  
Ahmad

Filed: 04 August 2003

Confirmation No.: 5211

For: INFORMATION-BEARING PAVEMENT TAPE

06 March 2008

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION TO THE DIRECTOR UNDER 37 CFR §§ 1.181 and 1.182**

Dear Sir:

Applicants hereby petition under 37 C.F.R. §§1.181 and 1.182 for entry and consideration of the Reply Brief filed 22 October 2007.

**Statement of Facts**

1. On 02 March 2007, Appellant filed a Notice of Appeal, and on 02 May 2007, Appellant filed an Appeal Brief in the above-referenced application (hereinafter, the “943 Application”).

2. An Examiner’s Answer to the 02 May 2007 Appeal Brief (the “Examiner’s Answer”) was mailed on 22 August 2007. The Examiner’s Answer included a subject heading that addressed previously cancelled claims 12-19, and a substantive rejection of claim 19. See Attachment A at page 4, third paragraph and at page 5, second paragraph, respectively.

3. This heading was not included, and claim 19 was not substantively rejected, in the Office Action mailed 04 December 2006 (to which the Appeal Brief of 02 May responded). See Attachment B.

4. On 22 October 2007, Applicants filed a Reply Brief (the "Reply Brief") in compliance with the requirements of 37 C.F.R. 41.41 and MPEP 1208. See Attachment C. It was unclear whether the Examiner was presenting a new ground of rejection in the substantive rejection of claim 19, or whether claims 12-19 and the substantive rejection of claim 19 were typographical errors. Hence, Appellant responded to the rejection of claim 19 by re-iterating, *verbatim*, the Examiner's subject heading, by requesting clarification of status of claims 12-19, and by clearly stating (multiple times) that claims 12-19 had been previously canceled and were not substantively argued in the Reply Brief. See Attachment B at page 2 of 38, first paragraph; at page 4 of 38, first paragraph; at page 12 of 38, first paragraph under Argument (B); at page 27 of 38, first paragraph, and at pages 36-37 of 38, under Argument F.

5. On 08 January 2008, a notice of non-entry was mailed (the "Notice"). The Notice stated that the Reply Brief was not considered due to non-compliance with 37 C.F.R. § 41.41(a), specifically because "the Reply Brief appears to be directed to addressing claims that had been cancelled by the appellant and admitted in said reply brief. Further, appellant has re-iterated the arguments from the Appeal Brief of 5/2/2007." See Attachment D at page 2, item number 1.

6. The Reply Brief was, in fact, compliant with §41.41(a).

A. The Reply Brief did not include any new or non-admitted amendment, affidavit or other evidence. 37 C.F.R. § 41.41(a) states only that "(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer [; and] (2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal." Since the Reply Brief did not include any matter prohibited by §41.41, it was and is compliant with Rule 41.41(a).

B. 37 C.F.R. §41.41(a) does not prohibit reiterating arguments from an Appeal Brief in a Reply Brief, and Appellant has found no other prohibition against such reiteration in MPEP chapter 1200. Appellant's representative pointed this out to Examiner Ahmad, in a telephone interview conducted 30 January 2008. Examiner Ahmad agreed that Appeal Brief arguments could be reiterated in a Reply Brief. In a subsequent Interview Summary mailed 05 February 2008, the question of reiterating Appeal Brief arguments was dropped. See Attachment E.

C. 37 C.F.R. §41.41(a) does not prohibit reiterating an Examiner's subject headings. The Reply Brief reiterated the subject headings, in order to clearly show that each ground of rejection presented by the Examiner was addressed. Again, Appellant did not substantively argue cancelled claims, and clearly requested the Examiner's clarification as to status of claims 12-19. See number 4, above.

7. Appellant is required to address new grounds of rejection. The Examiner's Answer included what may have been either a new ground of rejection or a typographical error. Pursuant MPEP §1208(I)(B), "Where a new ground of rejection is made in an examiner's answer, 'the appellant *must file a reply brief to address each new grounds of rejection* set forth in the answer in compliance with 37 CFR 41.37(c)(1)(vii)," emphasis added. In order to comply with this requirement, Appellant reiterated the subject headings used by the Examiner, requested clarification of whether or not claims 12-19 were indeed rejected, and several times noted that claims 12-19 were cancelled, and were therefore not substantively argued. The Examiner's statement that "the Reply Brief appears to be directed to addressing claims that had been cancelled by the appellant and admitted in said reply brief," is therefore inaccurate, as a thorough reading of the Reply Brief shows. See Attachment D at page 2, item number 1, quoted further above.

8. The Examiner objects to a problem of his own creation, and not one created by Appellant. Appellant attempted to fully address and respond to the Examiner, despite the problem.

A. The Examiner re-used subject headings from an old and out-of date Office Action. In the telephone interview of 30 January 2008, the Examiner noted that he listed cancelled claims along with rejected claims. The Examiner further indicated that he could not correctly note status of the claims since he copied headings from a previous office action. Note that these headings did not come from the 04 December 2006 Office Action, to which the Appeal Brief responded. It appears that the headings were copied from an office action mailed 24 October 2005, which is more than three years old. See Attachment F at page 4, item 4. The Examiner explained that he was not allowed to change headings from a prior office action, where copied (note, however, that there is no requirement on the Examiner to copy headings, let alone from an outdated office action). The Examiner also stated that his use of old headings was not confusing, since none of the cancelled claims were substantively rejected. However, this statement is incorrect. Claim 19 is included in a substantive rejection on page 5, second paragraph of the Examiner's Answer. See Attachment A.

The Examiner modified this position to state that "none of the cancelled claims were addressed in the Examiner's Answer." See Interview Summary mailed 05 February 2008, page 3. Respectfully, nonetheless, the Examiner's Answer still presents rejections of cancelled claims, and these rejections fall under a heading that states "[t]he following grounds of rejection are applicable to the appealed claims." See the Examiner's Answer at page 3, under item (9).

B. The Reply Brief reiterated the subject headings used by the Examiner, in an attempt to meet the requirements of MPEP § 1208(I)(B) (see number 7, above).

C. The Reply Brief specifically requested that the Examiner clarify whether or not the amendment cancelling claims 12-19 had been entered. See

Attachment C at page 2 of 38, first paragraph; at page 4 of 38, first paragraph; at page 27 of 38, first paragraph, and at pages 36-37 of 38, under Argument F; see also Attachment A at page 2, number 4 for the Examiner's rejection.

**D.** Contrary to the Examiner's Note (see Attachment D at page 2, item 1), the Reply Brief did not substantively argue any cancelled claim. Appellant used the same subject headings that the Examiner used, to avoid confusion and to make it clear that each of the Examiner's points was answered. However, as clearly pointed out in the introductory paragraphs of the Reply Brief and thereafter, previously-cancelled claims were not substantively argued in the Reply Brief, even though the Examiner substantively rejected cancelled claim 19. See Attachment B at page 4 of 38, first paragraph and at page 12 of 38, first paragraph under Argument (B); see also Attachment A at page 5, second paragraph; see also second paragraph under item **8 A**, above.

**9.** Non-entry of Appellant's reply brief "hides the ball" from the Appeal Board. This reply brief points out inconsistencies in prosecution that are relevant to the appeal proceedings. Furthermore, the Appeal Board may wish to remand the instant application to the Examiner for clarification, once and for all, of these inconsistencies. Hence, Appellant should be given the opportunity to present these inconsistencies to the Board, in the 22 October reply brief.

**10.** Refusing to enter the reply brief places Appellant in a catch-22. By refusing to enter the reply brief (essentially on grounds that an action by the Examiner is ok, but an attempted thorough response to that action is not), the Examiner discounts Appellant's good faith attempt to comply with the requirements of MPEP §1208(I)(B) in favor of his own preferences. Again, the Examiner presents no statutory failing by Appellant, but rather balks at Appellant's attempt at a thorough and clear response to the Examiner's apparent rejection of cancelled claims. The Examiner has not withdrawn the Examiner's Answer, hence, what appears to be a new, substantive rejection of claim 19 still stands on the record. Appellant is thus placed in the impossible position of either (a) appealing the Examiner by discounting the requirements of MPEP §1208(I)(B) (by

leaving a standing “new” grounds of rejection unanswered in a reply brief), or (b) complying with the requirements of MPEP §1208(I)(B), as could have been best understood in this situation, but then having the reply brief refused entry.

**11. The Examiner has not provided any means for filing a new reply brief.**

The Examiner has indicated that another Reply Brief may be filed; however, the period for such filing had long passed by the time the Interview Summary, and even the previous Notice of Non-Entry, was mailed (5 February and 08 January, 2008). See Attachment E. No new date for filing a revised Reply Brief has been given. Hence, Appellant hereby petitions for entry of the existing Reply Brief of 22 October 2007.

**Points to be Reviewed**

The Reply Brief should be entered and considered by the Board of Appeals. The Reply Brief of 22 October 2007 is in compliance with 37 C.F.R. §41.41(a). Furthermore, the Reply Brief did not substantively argue any cancelled claim, but reiterated the Examiner’s subject headings and clearly requested clarification of claim status, in an effort to comply with the requirements of MPEP §1208(I)(B).

**Action Requested**

Applicants respectfully request entry and consideration of the Reply Brief of 22 October 2007. Applicant further requests a refund of the fees required in connection with this Petition, since it is believed that the Reply Brief of 22 October 2007 should rightfully have been entered upon filing.

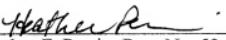
**Conclusion**

This Petition is timely filed within two months of the mailing date of the notice of non-entry, from which relief is requested. In accordance with the requirements of C.F.R. §1.17(f), the Commissioner is hereby authorized to charge any fee associated with this Petition to Deposit Account No. 12-0600.

Should any issue remain outstanding, the Director is encouraged to telephone Appellant's representative, Curtis A. Vock, at (720) 931-3011.

Respectfully submitted,

LATHROP & GAGE LLC

  
Heather F. Perrin, Reg. No. 52,884  
4845 Pearl East Circle, Suite 300  
Boulder, Colorado 80301  
Tel No: (720) 931-3033  
Fax No: (720) 931-3001